

**REMARKS**

Thorough examination of the application is appreciated.

Before discussing the details below, It is respectfully noted that claims 15-16 were exposed to examination and review, were noted as “rejected” on the examiner’s form PTOL-326, and yet were not formally or specifically discussed in any way the action in question (pages 2-5), leaving substantial question as to the basis of their rejection and an inability by Applicant to respond.

It is therefore respectfully proposed that while Applicant has attempted to “extrapolate” the Examiners unidentified concerns regarding claims 15-16 and have discussed these claims below, claims 15-16 are allowable on their face for failure to incorporate into the Examiner’s discussion, and that should a subsequent action be made final, that claims 15-16 should be excluded for this reason until they have received the specific attention of the examiner.

Similarly, at this point, there is no proof in the action that claims 15-16 (added earlier) were reviewed, rendering the instant action formally incomplete. However, in the interest and spirit of a speedy review, applicants have chosen to respond rather than request a complete action.

Claims 6-16 are pending, with claims 6, 15 and 16 being independent. Claim 12 is canceled without prejudice. The pending claims have been

selectively amended. Claims 9, 10 and 12 stand rejected under 35 U.S.C. 112, first and second paragraphs. Claim 6-8 and 11-14 stand rejected under 35 U.S.C. 103(a) as unpatentable over US 5,547,903 (“Brown”) in view of US 5,875,488 (“Milani”). Claims 15-16 were not reviewed but are discussed herein.

**1. 35 U.S.C 112, first paragraph rejection of claim 9, 10 and 12**

As to Claims 9 and 10, the Examiner’s attention is respectfully drawn to p. 5 of the original specification disclosing that a slit can be “substantially square or circular.” Claim 12 is cancelled without prejudice. In view of the earlier clear reference in the original specification withdrawal of the 112 rejections is respectfully requested.

**2. 35 U.S.C. 103(a) rejection**

The Examiner contends that a combination of Brown and Milani renders a structure, as recited by Claim 6, obvious. Applicant respectfully traverse this submission, recall the requirements of Graham v. John Deer for reference combination and review, and submits that a combination of Brown and Milani cannot yield a resultant structure that would have all of the recited

elements of Claim 6 absent Examiner modification. It is well known that if a resultant structure following combination does not have all the recited elements, then the Office has failed to establish the *prima facie* case of obviousness. It is respectfully proposed that the instant action has failed to achieve the status of a *prima facie* obviousness rejection.

The present disclosure teaches a band used as ponytail retainer that also can keep certain body parts warm.

Specifically, it is noted that instant claim 6 has been amended to recite, among others, the following limitations:

*-a ... continuous one-piece body ... having a substantially unbroken circumference...*

*the unbroken circumference having an opening...-*

In contrast to the present invention, the examiner explicitly admits that Brown does not teach an opening in a band. See Office Action p. 4, second paragraph.

The Examiner also relies upon solely Milani in an attempt to cure the deficiencies of Brown. Milani discloses constructing multi-piece headgear apparel including a headband, which in contrast to the present invention has a discontinuous body, and a pair of resilient bands, which are sewn to and bridge the spaced ends of the body. See Milani, col. 2, lines 38-42; Fig. 4. The bends

define an opening sized to receive the wearer's hair. Further, Milani contains no teaching or suggestion to modify its own disclosure or that of any other reference, leaving as the sole likely source hindsight review.

The Examiner contends that "[It] would be obvious to one having ordinary skill in the art at the times the invention was made to make the sweatband of Brown et al. with a slit, as taught by Milani..." without locating a source for this belief other than the Examiner. OA, p. 4, last sentence of first full paragraph. It is proposed that the examiner is incorrect in this assertion absence support or teaching from a reference as required and therefore that *prima facie* obviousness cannot exist.

Milani explicitly teaches (and hence requires) that an opening is defined between two straps which, in turn, are a separate component sewn to the opposite ends of a body. To export the teaching of Milani to Brown, the Examiner must a) provide Brown with two elastic straps, as taught by Milani; and b) attach the straps to the band of Brown in a non-suggested modification.

The resultant structure would have a continuous or "openingless" band of Brown and two straps of Milani attached to the inner or outer surface of the Brown's continuous body and defining an opening. As a consequence, the resultant structure would be structurally different from a continuous body provided with an opening, as recited by Claim 6.

Still a further possible modification of Brown in light of Milani would

include cutting a continuous band of Brown and bridging the spaced ends of the band by two straps of Milani. Clearly, such a resultant structure would physically differ from a continuous one-piece body, as recited by Claim 6.

What is an impossible combination is a one-piece band provided with an opening, as recited by Claim 6 because neither the base reference nor the secondary one teaches a continuous band with an opening. Note that Milani suggests a discontinuous band that has no opening in it. It is only an additional component, a two-strap structure, of Milani that suggests an opening for a ponytail. And that is the only element taught by Milani as a whole that one of ordinary skill would be motivated to consider. Similarly, as discussed above, importation of such a structure would not lead to a band as recited in amended Claim 6, unless the claimed structure is used (improperly) as a source of teaching absent any written suggestion, motivation, or teaching. This, however, amounts to the use of improper hindsight. Accordingly, Claim 6 is unobvious in light of a combination of the cited references and is patentable over this combination.

Claims 7-14 depend upon Claim 6 either directly or indirectly and benefit there from. In particular, Claims 7 and 8 additionally recite the components of the inventive structure that is clearly configured for a cold weather. In contrast, Brown and Milani have respective visors that are structured for a warm weather. For example, Brown is solely concerned with a

sweat absorber and sun blocker garment configuration. See Brown, col. 1, lines 37-47. One of the problems attempted to be solved by Brown is to allow “for the very rapid attachment of the visor 15 to the sweat band 11 is the sun is forward of the user in a sporting activity and for quick removal of the visor if not desired by the user.” Still a further problem attacked by Brown is “to add greater strength by the long curved portion 14” to a visor. Id Both problems and, therefore, respective solutions are typically associated with a warm weather. Accordingly, Claims 7 and 8 remove the recited structure even further from the cited prior art references.

Claim 15 and 16 have been amended to include the limitations discussed above in reference to claim 6 and despite their lack of any formal review as noted above, are thus patentable over the cited combination.

Therefore, it is respectfully proposed that the rejection of claims has been overcome, and withdrawal and reconsideration of the 35 U.S.C. 103(a) rejection as discussed in the action is therefore requested.

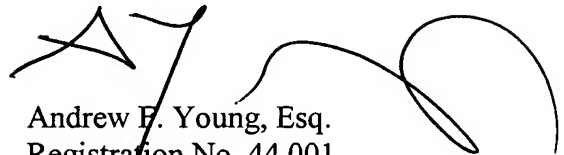
Applicant respectfully submits that she has answered each issue raised by the Examiner and that the application is accordingly in condition for allowance. Such allowance is therefore respectfully requested.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 10-0100.

In the spirit of condensed and streamlined practice, if the Examiner believes that a telephone conference would be of value, he is respectfully requested to call the undersigned counsel at the number listed below for prompt response.

Early and favorable action is respectfully solicited.

Respectfully Submitted,



Andrew F. Young, Esq.  
Registration No. 44,001  
Attorney for Applicant

Lackenbach Siegel, LLP  
One Chase Road  
Scarsdale, NY 10583  
914-723-4300  
Date: October 30, 2006